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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,322	09/22/2005	Eugen Rapp	13976	4832

7590
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EXAMINER

TAOUSAKIS, ALEXANDER P

ART UNIT	PAPER NUMBER
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3726

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09/28/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/510,322	Applicant(s) RAPP, EUGEN	
	Examiner ALEXANDER P. TAOUSAKIS	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 5-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/07/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of claims 1-4 in the reply filed on 07/15/2009 is acknowledged.

Claim Objections

Claim 1 is objected to because of the following informalities:

The claim fails to include a positive recitation of the method. A transitional phrase, such as "The procedure comprising" should be inserted after the preamble, as it is unclear where the preamble ends and where the method steps begin.

Lines 9-12 should be removed from the claim, as this limitation is a repeat of the previous limitation and appears to be written in error.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the base element" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "this deep-drawn plate" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "elastically yielding wall sections" in lines 7-8.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Sawdon et al (5,339,509).

1. Sawdon et al teach a procedure for pressed joint connections of components with at least one plate (*see Figure 13*), where a punch (125) passes through an opening in a base element of a die (134) to clinch at least one plate (14) without transecting, wherein the plate is deep-drawn and plastically deformed between a punch (125) and a base surface of the die (134) in the axial direction (*see Figure 13*), wherein a die (134) includes elastically yielding wall sections (142) (*see column 5 lines 50-61 and column 7 lines 30-46*), whereby the plate material undercuts non-deep-drawn areas of the plate (*see Figure 13*), wherein between the yielding wall sections (142) there are wall sections (146) which are connected to the base member (134) (*see Figure 13*), and the yielding wall sections (142) are displaceable to a surface parallel to the displacement direction (*see Figure 13, column 7 lines 30-46 and column 5 lines 35-56*).

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2. Sawdon et al teach the method of claim 1, wherein the radial path of the yielding wall sections (142) is limited during the deep-drawing operation to provide a leak proof seal (*see column 3 lines 34-35 and Figure 13, where it is shown that the path of wall section 142 is limited by member 149*).
3. Sawdon et al teach the method of claim 1, wherein the radial limit of the radial path of the die member is modifiable (*see Figure 13 and column 5 lines 35-56*).
4. Sawdon et al teach the method of claim 1, wherein the punch (125) remains attached to the components in a rivet-like and form-fit manner (*see Figure 13*).

Double Patenting

Claims 1-4 of this application conflict with claim 1 of Application No. 12/214,369. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a Clear line of demarcation between the applications. See MPEP § 822.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

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F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of copending Application No. 12/214,369. Both applications claim a method of forming pressed joint connections wherein a punch passes through an opening in a die member to clinch a plate, wherein the plate undergoes plastic deformation between the punch and the die and a force is countered by elastically yielding wall sections, wherein the plate undercuts non-deep drawn areas of the plate, wherein the yielding wall sections are displaceable in a direction parallel to the displacement direction and wherein the radial path of the yielding wall sections is limited.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the '369 application "anticipates" claims 1-3 of the present application. Accordingly, application claims 1-3 are not patentably distinct from '369 claim 1. Since it is clear that the more specific '369 claim 1 encompasses the broader application claims 1-3, following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a

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claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 1-4 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 20 of U.S. Patent No. 7,150,086. Both applications claim a method of forming pressed joint connections wherein a punch passes through an opening in a die member to clinch a plate, wherein the plate undergoes plastic deformation between the punch and the die and a force is countered by elastically yielding wall sections, wherein the plate undercuts non-deep drawn areas of the plate, wherein the yielding wall sections are displaceable in a direction parallel to the displacement direction and wherein the radial path of the yielding wall sections is limited.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the patent "anticipates" claims 1-3 of the present application. Accordingly, application claims 1-3 are not patentably distinct from the patent claim 1. Since it is clear that the more specific patent claim 1 encompasses the broader application claims 1-3, following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Dependent claim 4 corresponds to patent claim 20.

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.This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEXANDER P. TAOUSAKIS whose telephone number is (571)272-3497. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alexander P Taousakis
Examiner
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